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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/574,831	12/19/2006	Thomas Giering	GIER3008/JEK	5012
23364 7590 01/29/2009 BACON & THOMAS, PLLC 625 SLATERS LANE FOURTH FLOOR ALEXANDRIA, VA 22314-1176				
EXAMINER				
KOSLOW, CAROL M				
ART UNIT		PAPER NUMBER		
1793				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/574,831

Applicant(s)

GIERING ET AL.

Examiner

C. Melissa Koslow

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 December 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SG/US)
Paper No(s)/Mail Date 12/15/08
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

This action is in response to applicants' amendment of 15 December 2008 and in the interview of 6 January 2009. The amendments to the claims have overcome the 35 USC 101 rejection, the 35 USC 112, first paragraph rejection over claim 17 and the 35 USC 112, second paragraph rejection over claim 15, the 35 USC 112, second paragraph rejection over claim 17 with respect to the meaning of "second luminescent substances" and the 35 USC 112, second paragraph rejection as to the meaning of "coding system". The interview has clarified that "coding" means "composition". Thus the rejection and objection based on this term are withdrawn. The response and interview have clarified that "mixed crystal" means any crystalline material and thus the rejection and objection based on this term are withdrawn. Applicant's arguments with respect to the remaining objections and 35 USC 112 rejections have been fully considered but they are not persuasive.

It is noted that the decision in the interview shows that the definition given in the response is incorrect and should not be used. The definition in the response is that "coding" means information. Information per se is not one of the statutory classes of inventions set forth in 35 USC 101. Thus the definition argued in the response would mean that the claims do not meet the requirements of 35 USC 101. Furthermore, this definition does not make sense with the rest of the claim since the rest of the claim is directed to a composition.

The disclosure is objected to because of the following informalities:

It is unclear what is meant by "complemented characteristically" and "mutually complementary luminescence emissions" in paragraph 5 and "complementarily overlap" in paragraphs 14, 18 and 19. Appropriate correction is required.

Applicants' argue that these phrases mean that the two emission spectra combine to form a single joint emission range. There is nothing in the specification to support this definition. Using the argued definition of "complement", which is to complete, paragraph 5 teaches that the first emission spectrum is completed characteristically by the second emission spectra. This teaching rebuts which is taught in the first half of the paragraph which teaches that the first and second emission spectra form a joint emission spectra and the two individual emission spectra overlap. Using the argued meaning, "mutually complementary luminescence emissions" is "mutually complete luminescence emissions", which does not make any sense. Using the argued definition, "complementarily overlap" means completely overlap, but the figures and the description of the joint emission spectrum indicates that the pairs do not completely overlap each other, but overlap in a subrange. Thus there is nothing in the specification to indicate that "complemented", "complementary" and "complementarily", as used by the inventors, has the argued definition. The objection is maintained.

The amendment filed 15 December 2008 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: the added U.S. patent numbers, which replaced the foreign document numbers.

Applicant is required to cancel the new matter in the reply to this Office Action or to provide evidence that the added U.S. patent numbers are equivalent to the foreign numbers which they replace.

Without any evidence that the added U.S. patent numbers are equivalent to the foreign numbers which they replace, the amendment is considered new matter.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 18 and 19 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The subject matter of claim 18 is nowhere found in the specification. The specification teaches values documents comprising the at least one pair of mutually associated luminescent substances, but not there is no teaching of a system comprising at least one pair of mutually associated luminescent substances and value documents comprising at least one of the substances that make up the pair.

The amendment did not overcome this rejection.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 2, 10, 11 and 16-19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 2 recites the broad recitation about 750 nm to about 2500 nm and the claim also recites about 800 nm to about 2200 nm and about 1000 nm to about 1700 nm which are the narrower statement of the range/limitation. This claim is indefinite since it results in undue multiplicity.

Claims 1, 17 and 18 are indefinite since it is unclear what is meant by "complemented characteristically". Claims 10 and 11 are indefinite since it is unclear what is meant by "complementarily overlap". Finally, Claim 16 is indefinite since it is unclear what is meant by "overlap each other complementarily".

Claims 18 and 19 are indefinite since it is unclear what is meant by "a coding system" since this phrase is not present in the specification. The claimed system is not a "system" as this term is used in U.S. claim practice in that it appears to be directed to a single composition, not a group of associated different compositions that can be used together, such as a red ink and a blue ink.

The arguments over the rejections of claims 1 and 16-18 are not convincing for the reason given above. Applicants argue that claim 2 is a Jepson claim. This is incorrect, the claim defines the number range using Markush language. The fact the claims use the correct Markush format does not mean that it is not indefinite. As stated above, the claim is rejected since there is undue multiplicity between the three number ranges. The rejection over claim 2 is maintained.

For the purposes of the art rejection, the Examiner is defining "coding system" to the same as the coding of claims 1 and 15.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection

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is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-19 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-16 of copending Application No. 10/574,663. Although the conflicting claims are not identical, they are not patentably distinct from each other because the composition printed onto the claimed document and the claimed document in Application No. 10/574,663 suggest the coding and value document claimed in this application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 1-12, 15, 16, 18 and 19 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 and 12-25 of copending Application No. 10/574,662. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claimed coding system and the claimed

document in Application No. 10/574,662 suggest the coding and value document claimed in this application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melissa Koslow whose telephone number is (571) 272-1371. The examiner can normally be reached on Monday-Friday from 8:00 AM to 3:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorenzo, can be reached at (571) 272-1233.

The fax number for all official communications is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/cmk/
January 29, 2009

/C. Melissa Koslow/
Primary Examiner
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